



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,647	08/02/2001	Carter D. Dougherty	BISP-001/01US	6502
23419	7590	10/21/2004	EXAMINER	
COOLEY GODWARD, LLP 3000 EL CAMINO REAL 5 PALO ALTO SQUARE PALO ALTO, CA 94306			CHEA, PHILIP J	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/921,647	Applicant(s) DOUGHERTY ET AL.	
	Examiner Philip J Chea	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1- 28 have been examined.

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 2/5/02 was filed after the mailing date on 3/5/02. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

3. The information disclosure statement (IDS) submitted on 4/29/03 was filed after the mailing date on 5/7/03. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

4. The disclosure is objected to because of the following informalities:

- Note page 5 paragraph 29 line 3, "on of the" is apparently "on the".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 2153

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 7 and 21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 7 recites the limitation "the group" in line 2. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 21 recites the limitation "the group" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-5 and 15-19 rejected under 35 U.S.C. 102(e) as being anticipated by Corbin (U.S. 6,295,542).

As per claims 1 and 15, Corbin discloses a system for providing contextual marked-up information, as claimed, comprising:

- receiving a request from a user for an information resource (see columns 4 and 5, lines 60-67 and 1-3, where a request for information is implied in order to start the processing engine);
- retrieving said information resource (see columns 4 and 5, lines 60-67 and 1-3, where retrieving information resource is considered receiving a file by processing engine);

Art Unit: 2153

- converting data in said information resource into inserted user-selectable object, thereby rendering a converted information resource (see columns 4 and 5, lines 60-67 and 1-3, where user-selectable objects = link, and rendering = generate); and
- providing said converted information resource to said user (see columns 4 and 5, lines 60-67 and 1-3, where providing to user is implied).

As per claims 2 and 16, Corbin further discloses:

- scanning text in said information resource for a selected key phrase (see columns 5 and 6, lines 27-67 and 1-5, where scanning = reading a character at a time, and key phrase = a WORD); and
- replacing said selected key phrase with an inserted user-selectable object (see column 6, lines 1-5, where user-selectable = hyperlink).

As per claims 3 and 17, Corbin further discloses replacing said selected key phrase with an inserted user-selectable object in the form of a uniform resource locator (see column 15, lines 32-52, where uniform resource locator = hyperlink).

As per claims 4 and 18, Corbin further discloses replacing said selected key phrase with an inserted user-selectable object in the form of a uniform resource locator with a key phrase identifier (see column 15, lines 44-51, where key phrase identifier are considered the brackets identifying the uniform resource locator).

As per claims 5 and 19, Corbin further discloses:

- parsing a markup language document into markup language tokens and text-only portions (see column 5, lines 27-67, where markup tokens = HTML tags, and text only portions = reading character strings).
- scanning at least one text-only portion for the presence of a key phrase (see column 5, lines 27-67, where key phrase = WORD); and
- replacing said key phrase with an inserted user-selectable object (see column 6, lines 1-5, where user selectable object = hyperlinks).

Art Unit: 2153

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6-12 and 19-26 rejected under 35 U.S.C. 103(a) as being unpatentable over Corbin as applied to claims 1 and 15 above, and further in view of Herz et al. (U.S. 5,754,939).

As per claims 6 and 20, although the system disclosed by Corbin shows substantial features of the claimed invention (discussed above), it fails to disclose obtaining user content characterization information classifying information within said information resource.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Corbin, as evidenced by Herz et al.

In an analogous art, Herz discloses providing contextual marked-up information, where a user requests and receives an information resource, and obtaining user content characterization information classifying information within said information resource (see column 56, lines 14-29, where content characterization = search profile).

Given the teaching of Herz et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Corbin by employing the content characterization information, such as disclosed by Herz et al., in order to serve the user better by learning the user's interest and matching articles that might be of interest (see Herz et al. column 55, lines 43-49).

As per claims 7 and 21, although the system disclosed by Corbin shows substantial features of the claimed invention (discussed above), it fails to disclose obtaining information including: content type, content subject area, and content comments.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Corbin, as evidenced by Herz et al.

Art Unit: 2153

Herz et al. further discloses content characterization information including: content type, subject area, and comments (see column 56, lines 16-28, where content type = (1), subject area = (3), and comments = (2)).

Given the teaching of Herz et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Corbin by employing characterization information including: content type, subject area, and comments, such as disclosed by Herz et al., in order to serve the user better by learning the user's interest and matching articles that might be of interest (see Herz et al. column 55, lines 43-49).

As per claims 8 and 22, although the system disclosed by Corbin shows substantial features of the claimed invention (discussed above), it fails to disclose receiving instructions to store said information resource as saved content associated with said user.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Corbin, as evidenced by Herz et al.

Herz et al. further disclose storing the information resource as saved content associated with said user (see column 57, lines 8-36, where proxy server stores the files the user has searched for).

Given the teaching of Herz et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Corbin by employing storage for previous information resources, such as disclosed by Herz et al., in order to serve the user better by learning the user's interest and matching articles that might be of interest (see Herz et al. column 55, lines 43-49).

As per claims 9 and 23, although the system disclosed by Corbin shows substantial features of the claimed invention (discussed above), it fails to disclose storing information resource as saved content associated with a group of individuals that includes said user.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Corbin, as evidenced by Herz et al.

Herz et al. further disclose storing said information resource as saved content associated with a group of individuals that includes said user (see column 75, lines 16-47, where saved content is in the form of clusters, which contain similar search profiles from different users including said user).

Art Unit: 2153

Given the teaching of Herz et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Corbin by employing storage for previous information resources associated with a group of individuals that includes said user, such as disclosed by Herz et al., in order to automatically locate groups of people with common interests (see Herz et al. column 73, lines 39-55).

As per claims 10 and 24, although the system disclosed by Corbin shows substantial features of the claimed invention (discussed above), it fails to disclose searching for documents stored by said group.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Corbin, as evidenced by Herz et al.

Herz et al. further disclose searching for documents stored by said group (see columns 75 and 76, lines 49-67 and 1-12, where searching is considered looking for a virtual community by searching search profiles stored in clusters).

Given the teaching of Herz et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Corbin by employing document searching stored by a group, such as disclosed by Herz et al., in order to automatically locate groups of people with common interests (see Herz et al. column 73, lines 39-55).

As per claims 11 and 25, although the system disclosed by Corbin shows substantial features of the claimed invention (discussed above), it fails to disclose searching for documents stored by said group according to content characterization information specified by said user.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Corbin, as evidenced by Herz et al.

Herz et al. further disclose searching for documents stored by a group according to content characterization information specified by said user (see columns 75 and 76, lines 49-67 and 1-12, where content characterization information is considered searching search profiles within cluster groups).

Given the teaching of Herz et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Corbin by employing searching documents

Art Unit: 2153

according to content characterization, such as disclosed by Herz et al., in order to automatically locate groups of people with common interests (see Herz et al. column 73, lines 39-55).

As per claims 12 and 26, although the system disclosed by Corbin shows substantial features of the claimed invention (discussed above), it fails to disclose delivering search results that include content characterization information.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Corbin, as evidenced by Herz et al.

Herz et al. further disclose delivering search results that include content characterization information (see columns 75 and 76, lines 49-67 and 1-12, where delivering search results is considered finding a community that share similar interests after searching through clusters of groups to determine similar search profiles).

Given the teaching of Herz et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Corbin by delivering search results that include content characterization information, such as disclosed by Herz et al., in order to automatically locate groups of people with common interests (see Herz et al. column 73, lines 39-55).

13. Claims 13-14, and 27-28 rejected under 35 U.S.C. 103(a) as being unpatentable over Corbin as applied to claims 1 and 15 above, and further in view of Sotomayor (U.S. 5,708,825).

As per claims 13 and 27, although the system disclosed by Corbin shows substantial features of the claimed invention (discussed above), it fails to disclose inserting a document summary user-selectable object into said information resource, when being invoked lists predetermined key phrases identified within said information resource.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Corbin, as evidenced by Sotomayor.

In an analogous art, Sotomayor discloses a summary page, invoked by a viewer, which lists key phrases identified within an information resource (see column 8, lines 44-67, where user-selectable is considered viewer hyperlinking).

Art Unit: 2153

Given the teaching of Sotomayor, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Corbin by employing a summary page window, such as disclosed by Sotomayor, in order to automatically identify key topics and phrases in a document's text (see columns 3 and 4, lines 62-67 and 1-8).

As per claims 14 and 28, although the system disclosed by Corbin shows substantial features of the claimed invention (discussed above), it fails to disclose document summary window wherein key phrases are organized in accordance with predetermined content categories.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Corbin, as evidenced by Sotomayor.

Sotomayor further discloses a summary page, invoked by a viewer, which lists key phrases identified within an information resource, wherein key phrases are organized in accordance with predetermined content categories (see column 8, lines 44-67, where content categories are considered table-of-contents, a concept index, a phrase index, or an abstract index).

Given the teaching of Sotomayor, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Corbin by employing predetermined content categories in a summary page, such as disclosed by Sotomayor, in order to automatically identify key topics and phrases in a document's text (see columns 3 and 4, lines 62-67 and 1-8).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bae, Steve et al.	US 6226645
Dasan, Vasanthan S.	US 5761662
Davies, Nicholas John et al.	US 5931907
DeRose, Steven et al.	US 5644776
Inoue, Kazunori et al.	US 6014678
Liu, Peiya et al.	US 5794257

Art Unit: 2153

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J Chea whose telephone number is 703-605-1202. The examiner can normally be reached on M-F 7:45-4:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip J Chea
Examiner
Art Unit 2153

PJC

A handwritten signature in black ink, appearing to read 'D. Dinh', with a long horizontal flourish extending to the right.

Dung C. Dinh
Primary Examiner